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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/084,975

03/01/2002

Jean-Louis H. Gueret

08048.0026-00

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08/04/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP

901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER

DOAN, ROBYN KIEU

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 08/04/2006

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/084,975  
Filing Date: March 01, 2002  
Appellant(s): GUERET, JEAN-LOUIS H.

**MAILED**  
**AUG 04 2006**  
**Group 3700**

JEREMY T. THISSELL  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 6/09/2006 appealing from the Office action mailed 12/28/2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

A statement identifying the related appeals and interferences which will directly affect and will be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,937,870	Gueret	8-1999
5,176,156	Ashtary et al	1-1993

## **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12, 20-27, 33-51, 61, 62, 64-72, 75-88, 91-104, 107, 108-111 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret (5937870) in view of Ashtary et al (5176156).

With regard to claims 1-3, 9, 22-27, 33-42, 96-98, 101-104 and 107-111, Gueret discloses a mascara brush (figs. 1-3) comprising a container (320) comprising a mascara product to apply to eyelashes, a wiper (321), a handle (323) attached to an end of a stem (101), a brush portion connected to one end portion of the stem (101.1), the one end of the stem having a longitudinal axis and a brush portion having a free end (104); the brush portion comprising a twisted wire core (103) having a left hand pitch (fig. 1d), at least part of the core being curved; the brush portion further having bristles of different lengths (fig. 1) comprising ends defining an envelope surface being asymmetrical about a midplane of the envelope surface; the brush portion is formed

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from a blank comprising a blank core and blank bristles defining a blank surface, an edge of the blank surface being nonrectilinear and the rectilinear edge portion being outwardly concave (fig. 1e). With regard to claims 4-8, 10-12, 20-21, 51, 67-68, 83-84, 99-100, Gueret also discloses the blank envelope surface being substantially axially, circularly symmetrical about the longitudinal axis of the core, the envelope surface and the brush portion having a maximum and a minimum cross section locating between axial ends of the envelope surface and the brush portion, the nonrectilinear edge portion being located in one of the first third and a last third of the length of the blank envelope surface (figs. 1a, b). With regard to claims 64-66, 69-72, 75-82, 85-88, 91-95, Gueret '870 also discloses the envelope surface (129b) being noncylindrical proximate a free end (at 128b) of a brush portion (120). Gueret does not disclose the free end of the brush portion not being aligned with the longitudinal axis of the one end portion of the stem and the brush portion comprising a core having a core free end, at least part of the core being curved such that a line to the core at any axial position along the core is not perpendicular to the longitudinal axis of the one end portion of the stem and a longitudinal axis of the core free end is not parallel to the longitudinal axis of the end portion. Ashtray et al discloses a mascara brush (fig. 2) comprising a stem (16) with two opposite ends, a brush portion (32) connected to one end (at 34) portion of the stem and the one end portion of the stem having a longitudinal axis and the brush portion having a free end that is not aligned with the longitudinal axis of the one end portion of the stem and the brush portion comprising a core (30) having a core free end (free end of brush 32), at least part of the core being curved (col. 3, lines 61-62) such that a line

to the core at any axial position along the core is not perpendicular to the longitudinal axis of the one end portion of the stem and a longitudinal axis of the core free end is not parallel to the longitudinal axis of the end portion (fig. 2). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the particular brush portion as taught by Ashtary et al into the mascara brush of Gueret for the purpose of enhancing the ability of the device to curl the eyelashes. In regard to claims 43-50 and 61-62, the above apparatus is inherently seen in the existence method claims.

Claims 14-16 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gueret in view of Ashtary et al.

With regard to claims 14-16 and 55, Gueret in view of Ashtary et al disclose a mascara brush comprising all the claimed limitations in claims 1 and 43 except for the shape of the blank surface being frustoconical-shape, fish-like shape, hourglass-like shape. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to the shape of the blank surface being frustoconical-shape, fish-like shape, hourglass-like shape, since such a modification would have involved a mere change in the shape of the component.

#### **(10) Response to Argument**

Appellant raises a number of issues in his brief which require rebuttal in this examiner's answer.

1) Appellant argues on page 14, lines 5-7, of the brief:

“Neither Gueret nor Ashtary, nor any combination thereof, provides any disclosure or suggestion of a device or a method, among other features a brush portion having a free end that is not aligned with [a] longitudinal axis of [an] end portion of [a] stem”

It is noted that the Examiner respectfully disagrees with Appellant’s argument because by looking at figure 2 of Ashtary’s reference and by reading the teaching in column 3, lines 61-64, one of an ordinary skill in the art would recognize that the one end (34) of the stem (28) having a longitudinal axis and as the core (30) extends out from the stem (28), the free end portion (32) of the brush portion curves off that longitudinal axis of the one end of the stem. With regard to the arguments of the method steps, the device shown by Ashtary et al will perform the method steps during normal operational use of the device.

2) Appellant argues on page 16, lines 20-21, of the brief:

“There is no motivation or suggestion to combine the applied references in a manner resulting in Appellant’s invention”

It is noted that the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In*

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*re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Ashtary et al teaches the brush portion can be slightly curved to further enhance the device's ability to curl the eyelashes (col. 3, lines 61-64), therefore, it is proper to combine the two references. Also, Ashtary et al does show not aligning as argued above, and as such, the motivation given is proper.

3) Appellant argues on page 18, line 16, of the brief:

"The applied references do not show a reasonable expectation of success"

It is noted that it is well known to use different shapes to better work with the natural curved shape of the eyelashes as shown by Gueret. Ashtary et al shows another art known curved shape for working with eyelashes to further enhance the ability to curl, and as such, it would be obvious to one of ordinary skill in the art that the shape suggested by Ashtary et al would be successful in the brush of Gueret.

4) Appellant argues on page 20, lines 4, 5, of the brief:

"There is no motivation to alter the shapes of the devices of the applied references"

The Examiner is noted that such argument is considered "change in shape" analysis and since the Appellant failed to show the criticality of the shapes, it has been held that a change in shape is generally recognized as being within the level or ordinary skill in the art. In *re Rose*, 105 USPQ 237 (CCPA 1955).



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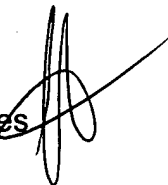
For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

RD

Conferees:

Samuel (Tom) Hughes  
TQAS, TC 3700



  
Cris Rodriguez  
Acting SPE, Art unit 3732